



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/656,477	09/05/2003	Carey E. Garibay	BEAS-01454US4	8635
23910	7590	10/31/2007		
FLIESLER MEYER LLP 650 CALIFORNIA STREET 14TH FLOOR SAN FRANCISCO, CA 94108			EXAMINER HEWITT II, CALVIN L	
			ART UNIT 3621	PAPER NUMBER
			MAIL DATE 10/31/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/656,477	GARIBAY ET AL.	
	Examiner	Art Unit	
	Calvin L. Hewitt II	3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 August 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-9,19 and 21-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-9,19 and 21-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Status of Claims

1. Claims 1, 3-9, 19, and 21-35 have been examined.

Examiner's Comment

2. Applicant's claims continue to recite limitations and/or language that suggest or makes optional but does not require steps to be performed. For example, claim 1 recites "providing a group application that *allows* a group administrator *to define...*" and "*so that*" these fields are displayed for members of the group the configuration input web page receiving...". In addition, claims 3, 21 and 29 recite "*can be used*", claims 7, 25 and 31 recite "*can change*", claims 19 and 28 recite "providing a group application that *allows* a group administrator *to define...*" and "*so that*", and claim 28 recites "the group administration application *is a web application that authenticates... and allows...*". Therefore, as language that does not require steps to be performed does not limit the scope of the claimed method (MPEP §2106 II C; Intel Corp. v. Int'l Trade Comm'n, 20 USPQ2d 1161 (Fed. Cir. 1991); In re Johnston, 77 USPQ2d 1788 (CA FC 2006)) what Applicant's claimed method may or may not do will not distinguish the claims from the prior art. In addition, Applicant attempts to further describe the method by relying on data stored in computer memory (e.g. configuration

information, maintaining transaction history *that indicates*, the group administration application *is a web application that authenticates...*). However, as the configuration information is not functionally related to the memory in which it is stored it will not distinguish the claimed method from the prior art (*In re Gulack*, 217 USPQ 401 (Fed. Cir. 1983), *In re Ngai*, 70 USPQ2d (Fed. Cir. 2004), *In re Lowry*, 32 USPQ2d 1031 (Fed. Cir. 1994), *Ex parte Masham*, 2 USPQ2d 1647 (1987); MPEP 2106.01 II).

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1, 3-9, 19, and 21-35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "the member" in line 8. There is insufficient antecedent basis for this limitation in the claim. Claim 19 is also rejected as it recites similar language. Claim 1 further recites "including *the fields defined*" in line 6. However, this limitation also lacks sufficient antecedent basis as the claim only requires a group administration application that "*allows* a group

administrator *to define* fields". Claims 19 and 28 are also rejected as each recites similar language:

Claims 3-9, 21-27 and 29-35 are also rejected as each depends from either claim 1, 19 or 28.

Claim 1 recites "the configuration input web page". However, it is unclear whether Applicant is referring to the "a configuration input web page" of line 3, or the "[providing] configuration input web page" (line 4) (note the absence of an article in front of the configuration input web page of line 4) (*In re Zletz*, 13 USPQ2d 1320 (Fed. Cir. 1989)). In addition, the language of "so that these fields are displayed for *members of the group the configuration input web page...*" is also unclear. For purposes of examination the language is being interpreted as follows:

- so that these fields are displayed for members of the group and allows the fields to receive information input from a member

Claims 19 and 28 are also rejected as each recites similar language.

Claims 3-9, 21-27 and 29-35 are also rejected as each depends from either claim 1, 19 or 28.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 3-9, 19, and 21-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Misra et al., U.S. Patent No. 6,189,146 in view of Singh et al. U.S. Patent No. 6,816,842.

As per claims 1, 3-9, 19, and 21-35, Misra et al. teach a method comprising providing configuration information concerning a software license (column 6, lines 50-64; column/line 7/25-8/33; column 13, lines 12-23) and maintaining a digital record of the license (column 7, lines 12-21; column 8, lines 35-67; column/line 9/29-10/60). Misra et al. also teach license information such as software environment (e.g. operating system), the number of licenses (e.g. number of CPUs), unique computer identifiers (abstract; column 9, lines 40-50; column 10, lines 50-60; column/line 12/40-13/11) and maintaining a transaction history that changes to the configuration information (column 6, lines 50-64; column 8, lines 35-67; column 16, lines 38-43 and 56-63; column 17, lines 8-25). Misra et al. do not specifically, disclose input fields for the input of configuration information. Singh et al. teach a licensing system where a customer requests a license by input license information into fields on a webpage (column 10, lines

12-27). Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Misra et al. and Singh et al. in order to provide a customer with an efficient method for entering data related to a license request ('146, column 6, lines 50-64; column 13, lines 12-32).

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

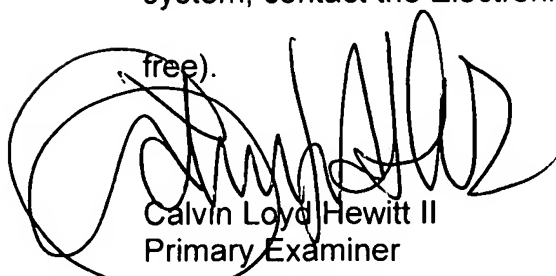
Art Unit: 3621

8. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Calvin Loyd Hewitt II whose telephone number is (571) 272-6709. The Examiner can normally be reached on Monday-Friday from 8:30 AM-5:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer, can be reached at (571) 272-6779.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-

free).



Calvin Loyd Hewitt II
Primary Examiner

October 24, 2007